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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,390	04/02/2001	Norihiko Kanae	109106	9343

25944 7590 12/22/2003

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EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

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DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,390

Applicant(s)

KANAE ET AL.

Examiner

HENRY N TRAN

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to the applicant's amendment and Notice of Appeal received 11/17/03 and 11/19/03 (Paper Nos. 20 and 21). The amendments to the specification and the claims have been entered. Claims 1-8 are pending in this application. Applicant's remarks were considered, with the results set forth as following. The indicated allowability of claims 8 is withdrawn in view of the newly discovered references to Morita et al (U.S. Patent No. 6,400,492). Rejections based on the newly cited reference follow.

Claim Objections

1. Claim 4 is objected to because of the following informalities: It's dependent upon a claim, which uses a non-numeric character: "claim I"

Examiner's suggestion: "claim I" must be changed to --claim 1--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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3. Claims 1-8 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over to Morita et al (U.S. Patent No. 6,400,492).

Morita et al teach an electrophoretic display device, comprising: a transparent conductive film 50; a resin layer 8 including a urethane resin, wherein the resin layer includes resin selected from acrylic resins or polyolefin type, wherein the thickness of the resin layer is preferably from about 0.1 ~~mm~~ to 100 ~~mm~~; a microcapsule layer 7, which includes a plurality of microcapsules and a binder affixing the plurality of microcapsules, is in contact with both the conductive film and the resin layer, a dispersion medium and a plurality of electrophoretic particles (Morita et al says the suitable materials for use in the overcoat layer 8 including the materials for use in the matrix, such as: acrylic resins, polyolefin type, and polyurethane type) (see figures 6A; col. 15, line 15 to col. 16, line 2; col. 18, line 57 to col. 19, line 8; col. 20, lines 59-67; col. 21, lines 18-23, lines 30-38, lines 42-44). Although Morita et al do not expressly teach that the urethane resin whose molecular weight is between 5000 to 2,000,000 is use in the resin layer. However, such a wide range provides no value added to the Morita et al.'s electrophoretic devices, which should carry such a claimed molecular weight because the overcoat layer 8 of the electrophoretic devices as taught by Morita et al. are made up from a selected composition of a large group of materials (see the references recited above). Moreover, in order to insure certainty in construing the claims in the light of the specification, the examiner has reviewed the disclosure, and found no description of what a typical molecular weight range is in the prior art, and why such a wide range is critical and important to the claimed invention. Lacking of an adequate disclosure of the criticality of that claimed feature as questioned above has lead to justify that no patentability weight is considered for that claimed limitation. Claims 1-8 are therefore rejected.

Response to Arguments

4. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Note: The applicants' Notice of Appeal (Paper No. 21) has been received on 11/19/03, and was placed in the file record.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is 703-308-8410. The examiner can normally be reached on Mon – Fri from 8:00AM – 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE, can be reached at 703-305-4709.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or fax to:

703-872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-306-0377.

Henry N. Tran

HENRY N. TRAN
Examiner
Art Unit 2674

Hnt
December 18, 2003